

AMENDMENTS TO THE DRAWINGS

Please **AMEND** Figures 1 – 3 in accordance with the attached replacement drawings, submitted in the Appendix. The attached 3 sheets of replacement drawings replace all prior versions and listings of Figures 1 - 3 in the application.

REMARKS

Summary of the Office Action

Figures 1 – 3 stand objected to for an informality.

Claims 16 and 17 stand rejected under 35 U.S.C. § 112, second paragraph as indefinite.

Claims 14 – 18 and 20 – 23 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Pre-Grant Publication No. 2001/0053110 by Shibuya (“Shibuya”).

Claims 19, 24, and 25 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Shibuya in view of U.S. Patent No. 6,556,533 to Fukakusa et al. (“Fukakusa”).

Summary of the Response to the Office Action

Applicant amends the Figs. 1 – 3 in accordance with the Replacement Drawings submitted with the attached Appendix.

Applicant cancels claim 16 without prejudice or disclaimer, and amends claims 14 and 17 to define the claimed subject matter further. Support for these amendments is found at least in paragraphs [0025] and [0149] – [0151] of the application as originally filed. Applicant also amends claim 23 to correct an informality. It is respectfully submitted that the above amendments introduce no new matter within the meaning of 35 U.S.C. §132.

Accordingly, claims 14, 15, and 17 – 25 are presently pending. Applicant requests entry of the Amendment and reconsideration and timely withdrawal of the pending rejections for at least the reasons discussed below.

The Objections to the Drawings

Figures 1 – 3 stand objected to for an informality. In response, Applicant amends Figures 1 – 3 in accordance with the three Replacement Drawings of the attached Appendix. Applicant respectfully submits that the amended drawings comply with the comments of the Office Action, and requests that the objection to the drawings be withdrawn.

The Rejections under 35 U.S.C. § 112, Second Paragraph

Claims 16 and 17 stand rejected under 35 U.S.C. § 112, second paragraph as indefinite. In response, Applicant cancels claim 16 without prejudice or disclaimer, and amends claim 17 to remove any reference to the features objected to. For at least these reasons, Applicant requests that the rejections of claims 16 and 17 under 35 U.S.C. § 112, second paragraph, be withdrawn.

The Rejections under 35 U.S.C. § 102

Applicants respectfully submit that the rejections of claims 14 – 18 and 20 – 23 must be withdrawn because the cited reference does not disclose, teach, or suggest all of the features of the claimed subject matter. “Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W.L. Gore & Assocs. V. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Further, “when evaluating the scope of a claim, every limitation in the claim must be considered. U.S.P.T.O. personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered.” *U.S.P.T.O. Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, page 9, October 26, 2005. As the Federal Circuit stated, “[a]nticipation requires the presence in a single prior art reference

disclosure of each and every element of the claimed invention, arranged as in the claim.”

Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)).

In view of this framework, Applicant amends independent claim 14 to recite, in part:

an operation unit, wherein if the wavelength of an incident beam is one wavelength of either the first or second wavelengths, carries out a subtraction operation between the signal of the first light receiving region and the signal of the second light receiving region that receives unnecessary light scattering over the substrate including the first and second light receiving regions, removes a signal component representative of the unnecessary light from the signal from the first light receiving region and outputs the detection signal representative of the first light wavelength, if the one wavelength is the first wavelength, and carries out a subtraction operation between the signal of the second light receiving region and the signal of the first light receiving region that receives unnecessary light scattering over the substrate including the first and second light receiving regions, removes a signal component representative of the unnecessary light from the signal from the second light receiving region and outputs the detection signal representative of the second light wavelength, if the one wavelength is the second wavelength.

As recited above, two light sources have different wavelengths in which one of the light sources is activated whereas the other of the light sources is not. By utilizing only one of the light sources, any output signal representative of the other light receiving regions that does not detect the proper reflecting light from the disc is subtracted from the output signal representative of the one of the light receiving regions that detects the proper reflecting light. As disclosed in the specification of the present Application, the offset due to the signal component corresponding to the unnecessary light reflected from the layer that is not used for recording or playing can be cancelled. This offset can also be cancelled for the three-beam method.

Shibuya, in contrast, discloses two light sources 2, 3 having different wavelengths that are

activated simultaneously. Shibuya at paragraph [0039]. Shibuya carries out the subtraction operation between the output signal representative of the region that receives the light having one wavelength and the output signal representative of the other region that receives light of the other wavelength. According to Shibuya at paragraph [0051], the offset due to the variation when an objective lens is shifted can be canceled. This offset, however, cannot be canceled using only one light source. Shibuya therefore necessarily fails to disclose two light sources have different wavelengths in which one of the light sources is activated whereas the other of the light sources is not. Furthermore, with two simultaneously activated light sources the offset due to the signal components of the unnecessary light reflected from the layer that is not used for recording or playing also cannot be cancelled.

For at least these reasons, claim 14 is allowable. Applicant respectfully submits that claims 15 – 18 and 20 – 23 are also allowable at least because they depend from allowable claim 14. Accordingly, Applicant requests that the rejection of claims 14 – 18 and 20 – 23 under 35 U.S.C. § 102 be withdrawn.

The Rejections under 35 U.S.C. § 103

Claims 19, 24, and 25 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Shibuya in view of Fukakusa. Applicant respectfully disagrees, and traverses these rejections for at least the following reasons.

To establish an obviousness rejection under 35 U.S.C. § 103(a), four factual inquiries must be examined. The four factual inquiries include (a) determining the scope and contents of the prior art; (b) ascertaining the differences between the prior art and the claims in issue; (c) resolving the

art; (b) ascertaining the differences between the prior art and the claims in issue; (c) resolving the level of ordinary skill in the pertinent art; and (d) evaluating evidence of secondary consideration. *Graham v. John Deere*, 383 U.S. 1, 17-18 (1966). In view of these four factors, the analysis supporting a rejection under 35 U.S.C. 103(a) should be made explicit, and should "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l. Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741 (2007). Furthermore, even if the prior art may be combined, there must be a reasonable expectation of success, and the reference or references, when combined, must disclose or suggest all of the claim limitations. *See in re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Here, Shibuya and Fukakusa, alone or combined, fail to disclose or suggest all the claim features of claims 19, 24, and 25 as they depend from amended claim 14. Fukakusa, the secondary reference, is cited by the Office Action to teach the additional features of claims 19, 24, and 25. Fukakusa fails at least to teach the feature of amended claim 14 of two light sources having different wavelengths in which one of the light sources is activated whereas the other of the light sources is not. Thus, even if one of ordinary skill in the art were to combine Shibuya and Fukakusa, the combined references still do not teach or suggest each and every feature of amended claim 14. Hence, claims 19, 24, and 25 are allowable at least because they depend from claim 14.

Since none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of the claimed subject matter, Applicant respectfully submits that claims 19, 24, and 25 are allowable. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 19, 24, and 25 under 35 U.S.C. §103(a).

CONCLUSION

Applicant believes that a full and complete response has been made to the pending Office Action and respectfully submits that all of the stated grounds for rejection have been overcome or rendered moot. Accordingly, Applicant respectfully submits that all pending claims are allowable and that the application is in condition for allowance.

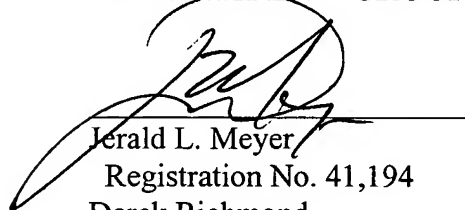
Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative at the number below to expedite prosecution.

Prompt and favorable consideration of this Reply is respectfully requested.

June 2, 2009

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APPENDIX